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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/539,330	06/15/2005	Declan P. Kelly	NL021460	9273
24737	7590	08/08/2006	EXAMINER	
PHILIPS INTELLECTUAL PROPERTY & STANDARDS P.O. BOX 3001 BRIARCLIFF MANOR, NY 10510			GOETZE, SIMON A	
			ART UNIT	PAPER NUMBER
			2631	

DATE MAILED: 08/08/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/539,330	Applicant(s) KELLY ET AL.	
	Examiner Simon A. Goetze	Art Unit 2631	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 June 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 June 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>6/15/05 & 3/15/06</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Information Disclosure Statement

1. The information disclosure statements submitted on March 15, 2006 have been considered by the Examiner and made of record in the application file.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 6 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Applicant states that the user identification is received at the *server* from the user in the first limitation, but the second limitation states that the *user* receives the user identification.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002

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do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

4. Claims 1-2 and 16-17 are rejected under 35 U.S.C. 102(e) as being anticipated by **Sivula (US Patent # 6,907,239)**.

Consider **claim 1**, Sivula discloses a method of enabling an electronic transaction, the method comprising the acts of:

providing storable electronic content to a user (*provide a service to the customer 16 – Figure 1 – Column 7, Lines 31-36*);

providing an electronic application to the user (*read as the application that supplies the user with the ringing tone to sample before purchasing – Figure 2 – Column 7, Lines 25-36*); and

providing control commands to the user for a fee that is receivable from a party other than the user (*provided from the prepayment server, the user sends an authentication key and the service provider can then reduce the amount remaining for the user from the prepayment server 50 – Figure 4 – Column 8, Lines 28-40*), the control commands enabling the electronic application to render the electronic content to the user (*read as the content is allowed to be downloaded to the phone once it is properly authenticated – Column 8, Lines 35-42*).

Consider **claim 2**, as applied to claim 1 above, Sivula further discloses that the storable electronic content and the electronic application are stored on a portable wireless device (*mobile*

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station MS for use with methods taught in Figures 1 and 2 applied to claim 1 – Figure 3 –

Column 7, Lines 37-38), and wherein providing the control commands comprises the acts of:

connecting the portable wireless device to a server (server 50 – Figure 5 – Column 8, Lines 41-42); and

transmitting the control commands from the server to the portable wireless device (read as once the user is authenticated and before the download from the server to the mobile station begins, a control command must be sent to the phone to initiate the download – Column 8, Lines 28-39).

Consider **claim 16**, as applied to claim 1 above, Sivula further discloses that the control commands control at least a selection of the electronic content (*read as an indication of a desired service and a request for the desired service – Column 2, Lines 40-42*).

Consider **claim 17**, as applied to claim 1 above, Sivula further discloses that the electronic content is at least audio (*ringing tone is used in an illustration of media that is downloaded – Column 4, Line 41*).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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6. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

7. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

8. Claims 3-4, 6-8, and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Sivula (US Patent # 6,907,239)** in view of **Lamkin et al. (US Patent Application Publication # 2004/0220926)**.

Consider **claim 3**, as applied to claim 2 above, Sivula discloses a portable wireless device that receives electronic content and control commands, but it does not require the commands to be sent every time the content is to be rendered for playback.

In related art, Lamkin et al. discloses a method wherein the control commands are required to be separately transmitted each time the electronic application renders the electronic content (*read as the access rights manager 482, which performs e-commerce transactions*

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through the content acquisition agent 472, may be required to obtain or validate licenses for entities before allowing playback each time – Figure 4 – Pages 17-18, Paragraphs 240-241), the method comprising the act of, at the server, maintaining a count of a number of times that the control commands are transmitted to the portable wireless device (usage counts are maintained in the metadata – Page 17, Paragraph 239; additionally the user may only be granted for a given number of these usage counts, and each time the file is accessed the usage count is decremented, Page 18, Paragraph 241).

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to incorporate the teachings of Lamkin et al. with those of Sivula in order to further control the distribution of content to wireless communication devices. This employs digital rights management, which protects the copyrights of media, to be applied to content, be it promotional or other secure distribution, supplied to a wireless communication device user.

Consider **claim 4**, as applied to claim 3 above, Sivula as modified by Lamkin et al. further discloses the act of denying transmittal of the control commands if the count exceeds a given number (*the file is no longer usable once the usage count is exceeded – Page 18, Paragraph 241 – Lamkin et al.*).

Consider **claim 6**, as applied to claim 2 above, (as best understood in view of the 112 2nd Paragraph rejection above) Sivula fails to disclose that the server receives a user identification each time the portable wireless device is connected to the server.

In related art, Lamkin et al. discloses that a user identification is received at the server each time the portable wireless device is connected and maintaining a count of a number of times

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the user identification is received by the user (*read as when the device is logged in the user is required to log in in order to provide identification, – Page 38, Paragraph 561*).

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to incorporate the teachings of Lamkin et al. with those of Sivula in order to be able to monitor when a user is online and to provide security to the network and track usage since all active users can be monitored.

Consider **claim 7**, as applied to claim 2 above, Sivula fails to disclose that the electronic content contains a plurality of electronic content portions which require control commands to be supplied each time they are rendered and the counting of these command transmissions.

In related art, Lamkin et al. discloses that the electronic content contains a plurality of content portions (*read as the media can be audio, video, documents, etc. and in the instance when it is a movie, some scenes may selectively have different access rights – Page 18, Paragraph 241 and Page 34, paragraph 513*), transmitting a control command in response to a request from the user containing a user identification (*user is required to log in in order to provide identification – Page 38, Paragraph 561*) wherein the request is for the control command (*read as the access rights manager 482, which performs e-commerce transactions through the content acquisition agent 472, may be required to obtain or validate licenses for entities before allowing playback each time – Figure 4 – Pages 17-18, Paragraphs 240-241*), and maintaining a count of a number of times that the control commands are transmitted to the portable wireless device (*usage counts are maintained in the metadata – Page 17, Paragraph 239; additionally the user may only be granted for a given number of these usage counts, and each time the file is accessed the usage count is decremented – Page 18, Paragraph 241*).

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It would have been obvious to a person having ordinary skill in the art at the time the invention was made to incorporate the teachings of Lamkin et al. with those of Sivula in order to have more control over the provisioned content, allowing the content to be used in a more effective manner for individual situations.

Consider **claim 8**, as applied to claim 7 above, Sivula as modified by Lamkin et al. further teaches the act of providing unrequested keys (*read as maintaining an authentication key validity database for verifying the validity of any of the generated authentication keys – Column 3, Lines 20-35 – Sivula*) determined from the count taught by Lamkin et al.

Consider **claim 10**, as applied to claim 1 above, Sivula fails to disclose that the electronic content contains a plurality of content portions and wherein a corresponding control command is required to be separately provided each time the electronic application renders one of the plurality of electronic content portions.

In related art, Lamkin et al. discloses that the electronic content contains a plurality of content portions (*read as the media can be audio, video, documents, etc. and in the instance when it is a movie, some scenes may selectively have different access rights – Page 18, Paragraph 241 and Page 34, paragraph 513*) and wherein a corresponding control command is required to be separately provided each time the electronic application renders one of the plurality of electronic content portions (*read as the access rights manager 482, which performs e-commerce transactions through the content acquisition agent 472, may be required to obtain or validate licenses for entities before allowing playback each time – Figure 4 – Pages 17-18, Paragraphs 240-241*).

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It would have been obvious to a person having ordinary skill in the art at the time the invention was made to incorporate the teachings of Lamkin et al. with those of Sivula in order to have more control over the provisioned content, allowing the content to be used in a more effective manner for individual situations.

9. Claims 11-15 and 18-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Sivula (US Patent # 6,907,239)** in view of **Donian et al. (US Patent Application Publication # 2004/0003398)**.

Consider **claim 11**, as applied to claim 1 above, Sivula fails to disclose the act of providing electronic advertising content renderable by the electronic application.

In related prior art, Donian et al. discloses the act of providing electronic advertising content renderable by the electronic application (*Pages 3-4, Paragraphs 49 and 55*).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to incorporate the teachings of Donian et al. with Sivula in order to raise additional money by providing an avenue for advertisers to promote their products and present advertisements to the end-user that are relevant to their usage.

Consider **claim 12**, as applied to claim 11 above, Sivula as modified by Donian et al. further teaches that the electronic application renders the electronic content and the electronic advertising content in a determined order (*read as the appropriate demand determines when the advertising is placed into the media – Page 4, Paragraph 55 – and the intersplicer 518 initializes settings 782 which can control how the playback proceeds – Page 18, Paragraph 230*).

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Consider **claim 13**, as applied to claim 12 above, Sivula as modified by Donian et al. further teaches that the electronic advertising is played back in between portions of the electronic content (*Page 4, Paragraph 55*).

Consider **claim 14**, as applied to claim 11 above, Sivula as modified by Donian et al. further teaches that the electronic advertising is provided together with the electronic content (*Page 4, Paragraph 55*).

Consider **claim 15**, as applied to claim 11 above, Sivula as modified by Donioan et al. fails to teach the use of geographic information to determine advertising.

However, Donian et al. further discloses that the storable electronic content and the electronic application are stored on a portable wireless device, and wherein providing the control commands comprises the acts of:

connecting the portable wireless device to a server (*ad manager 514 which is connected to media catalog 566 and also checks the master add table 670 or alternate ad table 660 – Figure 5B – Page 17, Paragraph 218*);

determining a geographic region where the portable wireless device is located (*by reviewing the parameters that define the geographic location of the device running the player – Page 17, Paragraph 214*);

identifying electronic advertising for the determined geographic region (*by reviewing the parameters that define the geographic location of the device running the player – Step 600, Figure 6 – Page 17, Paragraph 214*); and

transmitting the control commands and the identified electronic advertising from the server to the portable wireless device (*Pages 3-4, Paragraphs 49 and 55*).

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It would have been obvious to a person of ordinary skill in the art at the time the invention was made to incorporate these additional teachings of Donian et al. with Sivula in order to provide more appropriate advertising to the end-user so they are not presented irrelevant information which may discourage them from returning to the service.

Consider **claim 18**, Sivula discloses the method of enabling and electronic transaction, the method comprising the acts of:

providing storable electronic content to a user (*provide a service to the customer 16 – Figure 1 – Column 7, Lines 31-36*);

providing an electronic application to the user (*read as when the user is supplied the ringing tone to sample before purchasing – Figure 2 – Column 7, Lines 25-36*); and

providing control commands to the user for a fee that is receivable from a party other than the user (*provided from the prepayment server, the user sends an authentication key and the service provider can then reduce the amount remaining for the user from the prepayment server 50 – Figure 4 – Column 8, Lines 28-40*), the control commands enabling the electronic application to render the electronic content to the user (*read as the content is allowed to be downloaded to the phone once it is properly authenticated – Column 8, Lines 35-42*).

However, Sivula fails to disclose the determination and provision of electronic advertising based on a personal profile.

In related prior art, Donian et al. discloses the determination of electronic advertising based on a personal profile (*preference parameters 678 – Page 18, Paragraph 223*). Donian et al. also teaches that once appropriate advertising is selected, it is transmitted to the user (*Pages 3-4, Paragraphs 49 and 55 – using the intersplicer 518 which initializes settings 782 that can*

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control how the playback proceeds and prepares all of the content that is ordered by the user –

Page 18, Paragraph 230).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to incorporate the teachings of Donian et al. with those of Sivula in order to provide more appropriate advertising with the requested media to the end-user so they are not presented irrelevant information which may discourage them from returning to the service.

Consider **claim 19**, as applied to claim 18 above, Sivula as modified by Donian et al. fails to teach the acts of monitoring the user selection of electronic content and providing an update to the personal profile based on a result of the monitoring.

However, Donian et al. further teaches the acts of:

monitoring user selection of content (*read as the intersplicer 518 keeps an account of which ads have been seen, advertisements which have been selected based on content – Page 19, Paragraph 239*); and

providing an update to the personal profile based on a result of the monitoring (*read as the intersplicer can select new advertisements to present to the user in the case that a particular advertisement has already been seen – Page 19, Paragraph 239*).

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to incorporate the teachings of Donian et al. with those of Sivula so that the same advertisement is not repeatedly provided to the consumer, to maximize the effect of the advertising.

10. **Claim 9** is rejected under 35 U.S.C. 103(a) as being unpatentable over **Sivula (US Patent # 6,907,239)** in view of **Lamkin et al. (US Patent Application Publication #**

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2004/0220926), further in view of **Donian et al. (US Patent Application Publication # 2004/0003398)**.

Consider **claim 9**, as applied to claim 7 above, Sivula as modified by Lamkin et al. fails to disclose the act of providing electronic advertising content determined from the count, wherein the electronic advertising content is renderable by the electronic application.

In related prior art, Donian et al. discloses the act of selecting advertising content based on monitoring user selection of content (*read as the intersplicer 518 keeps an account of which ads have been seen, advertisements which have been selected based on content – Page 19, Paragraph 239*) and providing an update to the personal profile based on a result of the monitoring (*read as the intersplicer can select new advertisements to present to the user in the case that a particular advertisement has already been seen – Page 19, Paragraph 239*).

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to incorporate the teachings of Donian et al. with those of Sivula as modified by Lamkin et al. so that the same advertisement is not repeatedly provided to the consumer, to maximize the effect of the advertising.

11. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over **Sivula (US Patent # 6,907,239)** in view of **Ochiyama et al. (US Patent Application Publication # 2004/0031377)**.

Consider **claim 5**, as applied to claim 2 above, Sivula fails to disclose that the electronic application can only render the electronic content when connected to the server.

In related art, Ochiyama et al. discloses that the electronic application is only able to render the electronic content while the portable wireless device is connected to the server (*read as the TOC information is sent to the portable phone device 200 – Page 12, Paragraph 162*).

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It would have been obvious to a person having ordinary skill in the art at the time the invention was made to incorporate the teachings of Ochiyama et al. with those of Sivula in order to only allow content to be rendered while connected to a server, allowing only the most up to date information to be displayed, rather than information stored on the phone or media and to allow for further controlled management of distributed content.

Conclusion

12. The prior art made of record and not relied upon and is considered pertinent to applicant's disclosure is listed below.

US 2003/0125012	Allen et al.	Micro-Credit Certificate for Access to Services on Heterogeneous Access Networks
US 6,975,851	Boesjes	Distributed Wireless Online Access System
US 6,356,752	Griffith	Wireless Telephone as a Transaction Device
US 2004/0133794	Kocher et al.	Self-Protecting Digital Content
US 2004/0141582	Kocher et al.	Content Security Layer Providing Long-Term Renewable Security
US 2002/0095674	Lowthert et al.	Providing Content Interruptions
US 2002/0095675	Lowthert et al.	Providing Content Interruptions
US 2004/0125857	Rauber et al.	Method and System for Secure Distribution
US 2004/0197084	Tagawa et al.	Playback Program

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13. Any response to this Office Action should be **faxed to (571) 273-8300 or mailed to:**

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Hand-delivered responses should be brought to

Customer Service Window
Randolph Building
401 Dulany Street
Alexandria, VA 22314

14. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Simon A. Goetze whose telephone number is (571) 270-1113. The Examiner can normally be reached on Monday-Thursday from 7:30am to 5:00pm and Friday from 7:30am to 4:00pm.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Rafael Perez-Gutierrez can be reached on (571) 272-7915. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free) or 703-305-3028.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist/customer service whose telephone number is (571) 272-2600.

Simon A. Goetze
S.A.G./sag

July 18, 2006

EDAN ORGAD
PATENT EXAMINER/TELECOMM.

Edan Orgad 7/19/06